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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,204	04/24/2001	Nathan S. Lewis	06618-709001/CIT 2976-CIP	5403
41790	7590	09/20/2005	EXAMINER	
BUCHANAN INGERSOLL LLP (INCLUDING BURNS, DOANE, SWECKER & MATHIS) 12230 EL CAMINO REAL SUITE 300 SAN DIEGO, CA 92130			SINES, BRIAN J	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 09/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,204

Applicant(s)

LEWIS ET AL.

Examiner

Brian J. Sines

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 53-57, 72 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30, 34-37, 41, 42, 45, 49-52 and 58-71 is/are rejected.
- 7) ☒ Claim(s) 31-33, 38-40, 43, 44 and 46-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

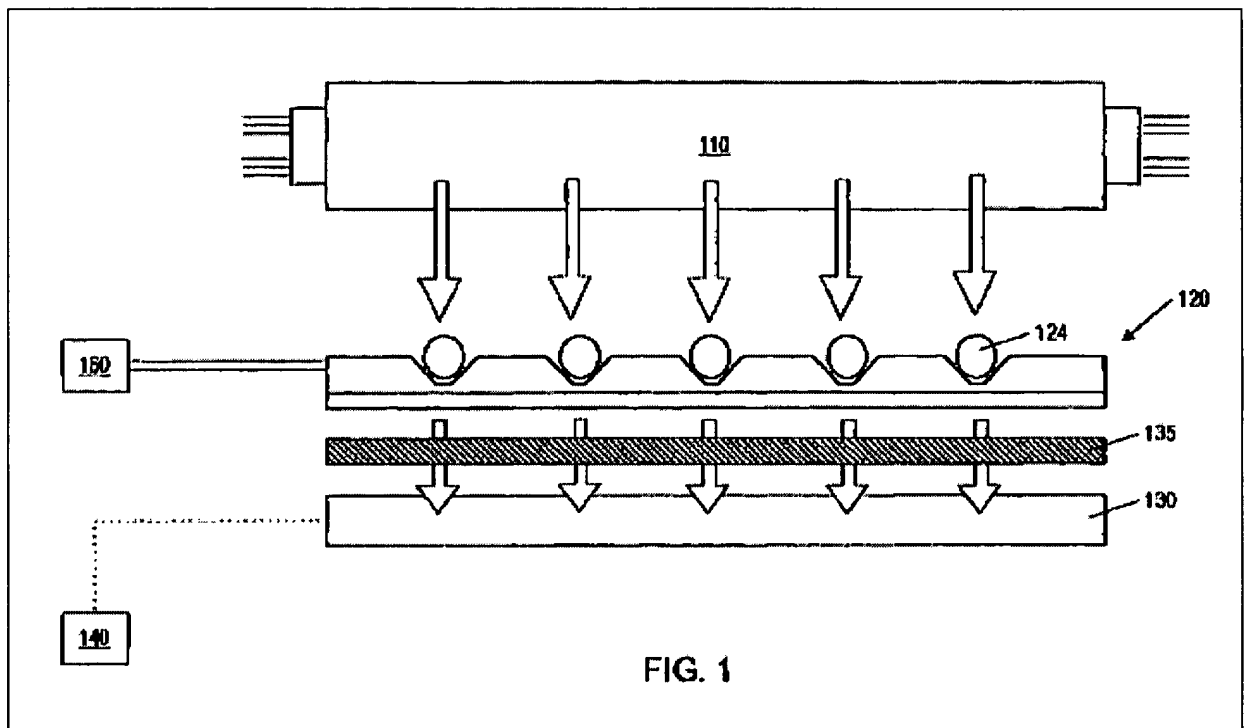
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

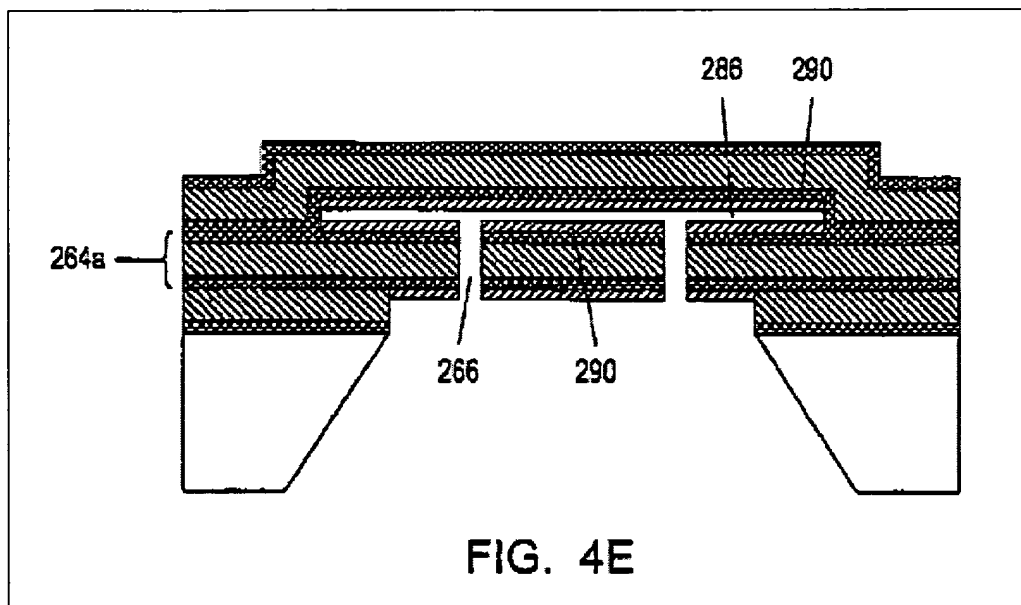
Claims 1 – 30, 34 – 37, 41, 42, 45, 49 – 52, 58 – 65 & 66 – 71 are rejected under 35 U.S.C. 102(e) as being anticipated by McDevitt et al. (U.S. Pat. No. 6,908,770 B1) (hereinafter “McDevitt”).

Regarding claims 1 – 26, 58 – 65 & 66 – 71, McDevitt teaches an apparatus comprising: a sensor array (120); a fluid flow system (e.g., micropumps and microvalves); and a processor (microprocessor 140) (see col. 7, lines 7 – 58; col. 8, lines 4 – 11; col. 10, lines 27 – 44; col. 19, lines 1 – 21; col. 22, lines 22 – 34; figures 1 & 4A – F). As shown in figure 4E, McDevitt indicates that holes or channels (etched windows 266) extend from a first surface to a second surface of the apparatus to cavity (286) (see col. 12, lines 4 – 17). McDevitt teaches that the disclosed sensing system can be used with either liquid or gaseous fluid systems (see col. 4, lines 15 – 21). The Courts have held that a statement of intended use in an apparatus claim fails to distinguish over a prior art apparatus. See *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987).

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Furthermore, the Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP § 2114).





Regarding claims 27 – 30, 34 – 37, 41, 42, 45 & 49 – 52, as discussed above, McDevitt teaches all of the positively recited structure of the apparatus provided in the claimed method, which merely recites the conventional operation of that apparatus. Regarding process or method claims, a prior art device anticipates a claimed process, if the device carries out the process during normal operation (see MPEP § 2112.02).

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered, but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

The indicated allowability of claims 1 – 30, 34 – 37, 41, 42, 45, 49 – 52, 59, 60 & 66 – 71 is withdrawn in view of the reference(s) to McDevitt et al. (U.S. Pat. No. 6,908,770 B1).

Claims 31 – 33, 38 – 40, 43, 44 & 46 – 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 31 & 46, the cited prior art neither teach nor fairly suggest that the first sensor has a sensor volume, wherein the sensor volume is optimized to cause the first sensor to generate a response having a maximum signal to noise ratio for at least one target.

Regarding claims 38, 40 & 44, the cited prior art neither teach nor fairly suggest the utilization of a spatio-temporal difference in sensor response generation and measurement.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

